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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,180	09/20/2001	Makarand P. Gore	10012215-1	4586

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EXAMINER

ACKUN, JACOB K

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/960,180	Applicant(s) GORE ET AL.	
	Examiner Jacob K. Ackun Jr.	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Haigh et al (3,999,653 cited by the applicant). The claimed inner casing reads on bottle 12 and the claimed outer casing reads on portions of the package external to the inner casing, such as the outer wall of jacket 17 and/or outer jacket 26 and/or packaging 72, 73, 75 and 76 in the embodiment of Fig 8. In the embodiment of Fig 1, the inner casing is considered to be less durable than the outer casing since the inner casing broke when impacted by the hammer while the outer casing was intact (note the description in column 8 lines 27+). The inner casing of Haigh is considered to be “integrally coupled” to the outer casing to the extent the requirement can be understood.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacikyan (6,530,472). Hacikyan discloses most of the elements of the claims, but may not disclose the claimed difference in durability between the outer and inner containers. However Hacikyan

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teaches that the word vial used to refer to inner casing 108 can be “any storage unit for liquid substances”, and storage units for liquid substances that are less durable than the shipping container disclosed in the reference are conventional. It would have been obvious in view of the above, to construct the inner casing 108 of Hacikyan from materials such that the inner casing was less durable than the outer casing, as a design expedient, or in order to provide a more cost effective container, for example, depending on the particular substance to be placed in the inner casing.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation that the inner casing is integrally coupled to the outer casing was not described in the disclosure s filed and thus constitutes New Matter. The limitation also does not meet the written description requirement because it is not clear what the applicant intends to be encompassed by the “integrally coupled” language now added to the claims.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. It is not clear precisely what structure is encompassed by the requirement that the inner container be "integrally coupled" to the outer container.

9. Applicant's arguments filed on 12/08/2003 have been fully considered but they are not persuasive. With regard to the "integrally coupled" terminology now relied upon by the applicant note the rejections under section 112 of the Statute as set forth above. With regard to the recitation that the inner casing is "configured to be in direct contact" with the material to be contained, it may be noted that the recitation is functional in claims 1-19, since no material is in fact claimed in these claims. The material is merely recited as an intended use of the claimed protective container. Accordingly, the function is considered to be met by either applied reference since each is inherently capable of receiving some material such that the material is in direct contact with whatever structure is identified by the examiner as the inner container. So for example even if Haigh did not disclose hazardous material within the portion of the packaging identified by the examiner as the inner casing, and in direct contact therewith, Haigh would meet the above noted function in product claims 1-19 because one could simply place such material inside the bottle.

The above comments notwithstanding it appears that the following should also be considered by the applicant. All of the prior art of record, including the applied references, teach packaging having multiple "layers". For example, as noted by the applicant with reference to the rejection over Haigh, the reference teaches a glass bottle 12 jackets 17 and 26 and packaging 72, 73 75 and 76. What the applicant may not appreciate based on the Remarks submitted on 12/08/2003 is that the claimed outer and inner casings may read on any of these "layers" subject only to limitations in the claims themselves. It is now well settled that during examination of a

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patent application, the claims are to be given their broadest reasonable interpretation in light of the specification, without reading limitations from the specification into the claims.

Thus, even if the rejections for New Matter and indefiniteness did not apply, Hacikyan would still meet claim 1 because the claimed protective container also reads on container 100 in the Fig 2 embodiment. There is no reason why the examiner must rely on vial 108 to meet the requirement of an inner casing, for example. The inner casing could be liner 112, the outer casing could be outer wall 102, and the preventative agent could be lining 110 that is impregnated with an absorbent polymer. It is believed that elements 112 and 102 can be described as "integral". Wall 102 would appear to be more durable than lining 112 based on their descriptions alone, and if not, it would certainly be obvious to provide the reference with this feature. Keeping in mind these comments, the cited prior art appears to be replete with examples of containers having "an outer casing" a less durable "inner casing" and a layer of "preventative agent" therebetween, whether or not the casings could be described as integrally connected. For these reasons the examiner is not convinced that claims having the scope of the claims at bar should be passed to issue.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

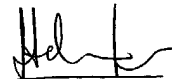
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (703)308-3867. The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703)308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacob K. Ackun Jr.
Primary Examiner
Art Unit 3712

J.A.